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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/231,415	01/14/1999	DON P. WOLFE	AUTOB.043A	3041
20995 7590 02/22/2010 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER COLBERT, ELLA				
ART UNIT		PAPER NUMBER		
3694				
NOTIFICATION DATE		DELIVERY MODE		
02/22/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com

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Office Action Summary

Application No.

09/231,415

Applicant(s)

WOLFE ET AL.

Examiner

Ella Colbert

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26, 100-114, 133, 134 and 142-144 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26, 100-114, 133, 134, and 142-144 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 26, 100-114, 133, 134, and 142-144 are pending. Claims 26 and 113 have been amended and claims 142-144 have been added in this communication filed 11/16/09 entered as Response After Non-Final Rejection.
2. The Specification Objections have been overcome by Applicants' amendments and are hereby withdrawn.
3. The claim objection to claim 113 has been overcome by Applicants' amendment to claim 113 and is hereby withdrawn.
4. The 35 USC 112, First Paragraph Rejection for claims 26, 100-114, 133, and 134 have been overcome by Applicants' convincing arguments and are hereby withdrawn.
5. The 35 USC 112, Second Paragraph Rejection for claims 26, 100-114, 133, and 134 from the Office Action mailed 03/05/09 has been overcome by Applicants' amendment and is hereby withdrawn. However, there are still remaining 35 USC 112, Second Paragraph Rejections as set forth here below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 26, 100-114, 133, 134, and 142-144 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 26 recites "a processor in communication with said software and configured to implement instructions of said software modules". It is vague and

indefinite what software modules the instructions are being implemented for. Do Applicants' mean the buyer-seller association software module and a seller access software module?

Claim 113 as amended recites "The purchase request management system of Claim 112, wherein the seller ... upon a copy of the purchase request being stored". This claim limitation is vague and indefinite. It is vague and indefinite as to where the copy of the purchase request is being stored. Is the copy of the purchase request being stored in a database or in a computer-readable medium?

Claims 100-114, 133, 134, and 142-144 are also rejected for their dependency from a rejected claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 26 and 100-104 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 7,236,983) Nabors et al, hereafter Nabors (claims priority to CIP No. 09/188,863 filed Nov. 9, 1998) in view of (WO 98/21679) Franklin et al, hereafter Franklin.

With respect to claim 26, Nabors discloses, a purchase request management system for multiple sellers to remotely manage purchase request records, the system

comprising: a plurality of purchase request records stored in a computer system remotely accessible via a network and created from data received from potential buyers, said data including buyer contact information and product information (col. 1, lines 24-51, col. 6, lines 2-6 and lines 7-14 and Fig. 7); a plurality of participating seller records comprising information about a plurality of participating sellers, said purchase request records and seller records stored on computer-readable medium (col. 5, line 59-col. 6, line 2); a buyer-seller association software module stored on a computer-readable medium and configured to assign each of said purchase request records to only a subset of the participating sellers in accordance with purchase request criteria, said purchase request criteria for each of said participating sellers predetermined in accordance with a relationship between a lead distributor and each of said plurality of participating sellers (col. 12, lines 25-62); a seller remote access software module executed on said computer system, stored on computer-readable medium, comprising computer-executable instructions that define one or more operations for viewing and managing said purchase requests records, and configured to provide each of said participating sellers with access to said computer system such that each seller can access only the subset of purchase request records which have been assigned to said seller by said buyer-seller association software module and can invoke the operations for viewing and managing said subset of purchase request records (col. 15, lines 7-23) and a processor in communication with said software modules and configured to execute software modules (col. 6, lines 15-26). Nabors did not expressly disclose a computer-readable medium for storing and executing a seller remote access software

module. Franklin discloses a computer-readable medium for storing and executing a seller remote access software module (page 14, lines 19-24, page 15, lines 1-13, page 16, lines 11-17, Page 17, lines 3-9, and Page 21, lines 3-11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nabors with the teachings of Franklin because such a modification would allow Nabors to have a collection of documents stored on a storage device and various databases for computer-based shopping on a merchant website.

With respect to claim 100, Nabors teaches, The purchase request management system of Claim 26, wherein the seller access module receives seller-enter information about at least one of the purchase requests and stores the seller-entered information in a system database (col. 8, line 55-col. 9, line 43 and Fig. 5).

With respect to claim 101, Nabors teaches, The purchase request management system of Claim 100, wherein the seller access module receives seller to assign at least one task related to at least one purchase request to a user associated with the seller (col. 3, lines 40-58).

With respect to claim 102, Nabors teaches, The purchase request management information about assigned tasks is stored in a system database (col. 5, lines 30-53).

With respect to claim 103, Nabors teaches, The purchase request management system of Claim 100, wherein the seller access module receives a seller entered status related to at least one purchase request (col. 5, line 61-col. 6, line 14).

With respect to claim 104, Nabors teaches, The purchase request management system of Claim 103, wherein information about purchase request status is stored in a system database (col. 5, line61-col. 6, line 14).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 105 and 106 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 7,236,983) Nabors et al, hereafter Nabors and (WO 98/21679) Franklin et al, hereafter Franklin in view of Auto-By-Tel Wins With Educated Customers And Low Prices", herein after Auto-By-Tel.

With respect to claim 105, Nabors and Franklin failed to teach, The purchase request management system of Claim 26, further comprising a system database comprising a plurality of product records, each product record corresponding to at least one product sold by at least one of the sellers and comprising at least a product type and an estimated product price. Auto-by-Tel teaches, further comprising a system database comprising a plurality of product records, each product record corresponding to at least one product sold by at least one of the sellers and comprising at least a product type and an estimated product price (page 3, paragraph 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to

incorporate the teachings of auto-by-tel in Nabors because such an incorporation would allow Nabors to have a collection of data stored on a computer storage medium that can be used for more than one purpose. For example, the dealers will be able to use the data to determine their inventory and profit margin.

With respect to claim 106, Nabors and Franklin failed to teach, The purchase request management system of Claim 105, wherein the system database is configured to be accessible over a computer network to at least one potential buyer using a remote terminal and to provide product information to the potential buyer. Auto-by-Tel teaches, wherein the system database is configured to be accessible over a computer network to at least one potential buyer using a remote terminal and to provide product information to the potential buyer (page 3, paragraph 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Auto-By-Tel in Nabors because such an incorporation would allow Nabors to have product information available to a buyer in order to match the buyer's specifications to the merchandise in the database.

Claims 107-114, 133, and 134 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 7,236,983) Nabors et al, hereafter Nabors and (WO 98/21679) Franklin et al, hereafter Franklin in view of "Auto-By-Tel Wins With Educated Customers And Low Prices", herein after and further in view of "Internet Auto Sales Service Can Return To Texas", herein after Internet Auto Sales.

With respect to claim 107, Nabors, Franklin and Auto-By-Tel failed to teach, further comprising a system database comprising a plurality of predefined sales regions

and each purchase request corresponds to at least one of the predefined sales regions based on at least one geographic designation associated with the buyer contact information. Internet Auto Sales teaches, further comprising a system database comprising a plurality of predefined sales regions and each purchase request corresponds to at least one of the predefined sales regions based on at least one geographic designation associated with the buyer contact information (page 1, lines 6-9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Internet Auto Sales in Nabors because such an incorporation would allow Nabors to have submission of customer's price request to the dealer assigned to the customer's zip-code area.

With respect to claim 108, Nabors, Franklin and Auto-By-Tel failed to teach, wherein the buyer-seller association module is configured to assign each purchase request to only one seller. Internet Auto Sales teaches, wherein the buyer-seller association module is configured to assign each purchase request to only one seller (page 1, lines 6-9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Internet Auto Sales in Nabors because such an incorporation would allow Nabors to have submission of customer's price request to the dealer assigned to the customer's zip-code area.

With respect to claim 109, Nabors, Franklin and Auto-By-Tel failed to teach, wherein the geographic designation associated with the purchase request is derived from contact information of the potential buyer to whom the purchase request corresponds. Internet Auto Sales teaches, wherein the geographic designation

associated with the purchase request is derived from contact information of the potential buyer to whom the purchase request corresponds (page 1, 6-9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Internet Auto Sales in Nabors because such an incorporation would allow Nabors to have submission of customer's price request to the dealer assigned to the customer's zip-code area and its distribution to clients of lists of subscriber dealers in the area that sell the particular vehicle.

With respect to claim 110, Nabors, Franklin and Auto-By-Tel failed to teach, The purchase request management system of Claim 109, wherein the geographic designation associated with the purchase request is derived from the potential buyer's zip code. Internet Auto Sales teaches, wherein the geographic designation associated with the purchase request is derived from the potential buyer's zip code (page 1, lines 6-9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the geographic designation associated with the purchase request is derived from the potential buyer's zip code and to modify in NaborsI because such a modification would allow Nabors to have customer data that is created and saved that contains the customer's address (an address contains a zipcode) which is basic information for any geographic designation.

With respect to claim 111, Nabors and Franklin failed to teach, the purchase request management system of Claim 26, further comprising a system database comprising a plurality of exclusive database regions, each exclusive database region being reserved for a single seller and being configured to store only those purchase

requests assigned to the single seller. Internet auto sales teaches, the purchase request management system of Claim 26, further comprising a system database comprising a plurality of exclusive database regions, each exclusive database region being reserved for a single seller and being configured to store only those purchase requests assigned to the single seller (page 1, lines 6-9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the geographic designation associated with the purchase request is derived from the potential buyer's zip code and to modify in NaborsI because such a modification would allow Nabors to have customer data that is created and saved that contains the customer's address (an address contains a zipcode) which is basic information for any geographic designation.

With respect to claim 112, Nabors teaches, the purchase request management system of Claim 111, wherein the buyer-seller association module is configured to assign each purchase request to one or more sellers by storing a copy of the purchase request in the exclusive database region of each assigned seller (col. 12, lines 25-62).

With respect to claim 113, Nabors teaches, wherein the seller access module is configured to provide each dealer with access to a purchase request upon a copy of the purchase request being stored (col. 12, lines 42-62).

With respect to claim 114, Nabors teaches, the purchase request management system seller access module provides access to each seller of only those purchase requests assigned to the seller by providing access to the seller of only the exclusive database region reserved for the seller (col. 13, lines 15-52).

With respect to claim 133, Nabors teaches, The purchase request management system of claim 26, wherein said purchase request criteria for said plurality of participating sellers are collectively configured to ensure that the system assigns each of said purchase request records to only one of a plurality of subsets of the participating sellers that sell the product identified in the purchase request record (col. 13, line 15-col. 14, line 48).

With respect to claim 134, Nabors teaches, The purchase request management system of claim 26, wherein the plurality of subsets of participating sellers for a given product includes at least one subset containing just one seller and each of the subsets of participating sellers for a given product more than a small number relative to the total number of participating sellers for a given product (col. 14, line 49-col. 15, line 60).

With respect to claim 142. Nabors teaches, The purchase request management system of Claim 26, wherein the buyer- seller association software module assigns each of said purchase request records to only a small subset of the participating sellers (col. 8, lines 7-61).

With respect to claim 143. Nabors teaches, The purchase request management system of Claim 26, wherein the buyer- seller association software module assigns each of said purchase request records to only a subset of the participating sellers, wherein the subset comprises between one and five of the participating sellers (col. 5, lines 16-29).

With respect to claim 144. Nabors teaches The purchase request management system of Claim 26, wherein the buyer- seller association software module assigns

each of said purchase request records to only a subset of the participating sellers, wherein the subset comprises between one and ten of the participating sellers (col. 5, lines 16-29 and col. 6, lines 16-26).

Response to Arguments

Issue no. 1: Applicants' argue:

The Applicants note that the present application was filed before the filing date of the Nabors patent. Accordingly, the Nabors patent cannot be prior art to the present application except with respect to subject matter that was disclosed in the parent application of the Nabors patent and the Applicants' submit that the Nabors parent application does not teach, fairly suggest, or render obvious every limitation of Claim 26.

Response: These arguments have been considered but are not persuasive because the amendments to claim 26 have necessitated the addition of another reference making these arguments moot.

Issue no. 2 Applicants' argue: The Examiner rejected Claims 105-114, 133, and 134 as allegedly being obvious in view of the Nabors patent combined with other art of record. The Applicants traverse the rejections. As set forth above with respect to 35 U.S.C. § 102, the Nabors patent does not teach, fairly suggest, or render obvious all of the claim limitations of Claim 26 or its dependent claims. Moreover, the other references cited by the Examiner do not teach, fairly suggest, or render obvious the claim limitations that are lacking in the Nabors patent. Accordingly, the Examiner has not shown that a person of ordinary skill in the art would have found the claims to have been obvious, in view of the art of record, as of the filing date of the present application.

Response: *Obviousness*

A claimed invention is unpatentable if the differences between it and the Prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 399 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: "[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved." 383 U.S. at 17-18. *See also KSR*, 550 U.S. at 406. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416.

"When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, 35 USC 103 likely bars its patentability." *Id.* at 417.

"For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve

similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *Id.*

"Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* at 420.

"Nilssen urges this court to establish a "reality-based" definition whereby, in effect, references may not be combined to formulate obviousness rejections absent an express suggestion in one prior art reference to look to another specific reference. We reject that recommendation as contrary to out precedent which holds that for the purpose of combining teachings, those references need not explicitly suggest combining teachings, much less specific references". *See, e.g., In re Sernaker*, 702 F.2d 989, 995,

MPEP 2133.03(a) [R-5] entitled "Public Use".

It should be noted that 35 USC 102(b) may create a bar to patentability either alone, if the device in public use or placed on sale anticipates a later claimed invention, or in conjunction with 35 USC 103, if the claimed invention would have been obvious from the device in conjunction with the prior art. *LaBounty Mfg. V. United States Int'l Trade Comm'n*, 958 F.2d 1066, 1071, 22 USPQ2d 1025 (Fed. Cir. 1992).

THE 1-YEAR TIME BAR IS MEASURED FROM THE U.S. FILING DATE

If one discloses his or her own work more than 1 year before the filing of the patent application, that person is barred from obtaining a patent. In *re Katz*, 687 F.2d 450, 454, 215 USPQ 14, 17 (CCPA 1982). The 1-year time bar is measured from the U.S. filing date. Thus, applicant will be barred from obtaining a patent if the public came into possession of the invention on a date before the 1-year grace period ending with the U.S. filing date. It does not matter how the public came into possession of the invention. Public possession could occur by a public use, public sale, a publication, a patent or any combination of these. In addition, the prior art need not be identical to the claimed invention but will bar patentability if it is an obvious variant thereof. In *re Foster*, 343 F.2d 980, 145 USPQ 166 (CCPA 1966). See MPEP § 706.02 regarding the effective U.S. filing date of an application.

The main question is "whether the primary purpose of the invention at the time of the sale, was to conduct experimentation". *Allen Eng'g Corp. v. Bartell Indus, Inc.*, 299 F.3d 1336, 1354, 63 USPQ2d 1769, 1780 (Fed. Cir. 2002), quoting *EZDock v. Schafer*

Sys., Inc., 276 F.3d 1347, 1356-57, 61 USPQ 2d 1289, 1295-96 (Fed. Cir. 2002) (Linn, J., concurring).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Flexible Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Trammell James can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3694

February 13, 2010